

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 3-10, 12-19, and 21-23 are currently pending in the present application, Claims 1, 10, and 19 having been amended by way of the present amendment, and Claims 2, 11, and 20 having been canceled by way of the present amendment. No new matter has been added.<sup>1</sup>

In the outstanding Office Action, Claims 1-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Okubo (U.S. Pat. Pub. No. 2003/0058471, hereinafter “Okubo”) in view of undocumented assertion as to the usage of APIs allegedly being a simple substitution of one type of program for another.

The Office Action cited paragraph [0024] of Okubo as teaching the updating of the image processing software according to an image processing application. The Office Action then concludes on page 2 that “Okubo is essentially updating a program specific to a particular image processing application.” Further, regarding the undocumented assertions on pages 2-3 and 5 as to the alleged obviousness of the usage of APIs allegedly being a simple substitution of one type of program for another, it is respectfully submitted that only by impermissible hindsight reconstruction would one know to update an API instead of the program of Okubo. Indeed, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

---

<sup>1</sup> Claims 1, 10, and 19 are amended to clarify features previously presented and to incorporate the subject matter of dependent Claims 2, 11, and 20, respectively.

Accordingly, Applicants traverse the 35 U.S.C. § 103(a) rejection based on the undocumented assertion on pages 2-3 and 5 of the Official Action. Okubo is directed to image processing that is capable of automatically adding or upgrading image processing functions without conducting a test installation of such programs. Applicants respectfully submit that Okubo merely describes comparing versions between a group (set) of currently installed programs and a group of programs in the server. Further, Okubo describes that if the version of the group of programs in the server is not newer than the version of the group of currently installed programs, the procedure ends without further processing.

More specifically, Okubo describes that multifunction-peripheral apparatus 1 has a program memory 35 which stores a plurality of individual image processing programs, which may be grouped, and that such group names are preferably stored in the program property memory 37. Further, Okubo describes that the downloader 31 requests and obtains version information Vinst for the individual image processing program candidates from the server 7.<sup>2</sup> The downloader 31 then reads, from the program property memory 37, program property information Vnow associated with the currently installed individual image processing programs.<sup>3</sup> Then, the downloader 31 verifies the version information Vinst with the program property information Vnow to determine whether the version information Vinst is newer than the program property information Vnow.<sup>4</sup>

Hence, when the version information Vinst is determined as newer, the program property information Vnow in Step S6 and the determination result of Step S6 is YES, the downloader 31 recognizes that the individual image processing program candidates are those to add or upgrade.<sup>5</sup> Thus, the downloader 31 starts downloading the individual image processing programs from the server 7. Okubo further describes that when the version

---

<sup>2</sup> See paragraph [0086] of Okubo.

<sup>3</sup> See paragraph [0086] of Okubo.

<sup>4</sup> See paragraph [0086] of Okubo.

<sup>5</sup> See paragraph [0086] of Okubo.

information Vinst is determined as not newer than the program property information Vnow in Step S6 and the determination result of Step S6 is NO, the downloader 31 recognizes that the individual image processing program candidates are not those to add or upgrade.<sup>6</sup> Then, the procedure ends.<sup>7</sup>

On the other hand, in the claimed invention, API-by-API comparison is performed when the versions of the sets of the APIs are different. Indeed, Okubo does not disclose or suggest the claimed API-by-API comparison. Further, Okubo does not disclose or suggest API-by-API comparison being performed when the versions of the sets of the APIs are different. M.P.E.P. § 2143.03 requires, to establish a case of *prima facie* obviousness, that all words in a claim must be considered in judging the patentability of the claim against the prior art. Further, M.P.E.P. § 2123 I states that a reference may be relied on for all it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

Applicant respectfully submits that Okubo is silent, does not disclose, and does not reasonably suggest “a comparing unit configured to compare, API by API, version information of the one of the plurality of the APIs used by the application with version information of the one of the plurality of the APIs of the system service,” and “a further comparing unit configured to compare a version of a set of the APIs used by the application with a version of a set of APIs of the system service, wherein the image forming apparatus performs comparison by the comparing unit only when the versions of the sets of the APIs are different,” as recited in amended Claim 1.

Therefore, Applicants submit that the Official Action has failed to produce a *prima facie* case of obviousness. Accordingly, as Okubo does not disclose or suggest all the

---

<sup>6</sup> See paragraph [0087] of Okubo.

<sup>7</sup> See paragraph [0087] of Okubo.

elements of Claim 1, Applicants respectfully submit that Claim 1 (and Claims 3-9 dependent therefrom) is patentable over Okubo for all of the above reasons.

Independent Claims 10 and 19, while differing in scope and statutory class from Claim 1, patentably define over Okubo for substantially the same reasons as Claim 1. Accordingly, it is respectfully submitted that Okubo does not anticipate or render obvious the features of independent Claims 10 and 19. Therefore, independent Claims 10 and 19 (and the claims dependent therefrom) are believed to patentably define over the applied reference.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

James J. Kulbaski  
Attorney of Record  
Registration No. 34,648

Customer Number

22850

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)

Scott A. McKeown  
Registration No. 42,866